REMARKS

Comments on Restriction Requirement

Applicants hereby elect, with traverse, to prosecute Group A, which includes and is drawn to Claims 1-7, 9, 11-14, and 16-17. Applicants further elect the polypeptide of Group 25 (SEQ ID NO:28), and the polynucleotide of Group 59 (SEQ ID NO:65) with respect to the examination of those claims. Applicants traverse the Restriction Requirement for at least the following reasons.

I. The unity of invention standard ***must*** be applied in national stage applications

Section 1850 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) (hereinafter "MPEP") provides:

> ... [W]hen the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111....
>
> In applying PCT Rule 13.2 to ... national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2....

Id at page 1800-60 to -61.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

> Examiners are reminded that unity of invention (not restriction) practice is applicable ... in national stage (filed under 35 U.S.C. 371) applications.

Id at page 1800-149, column 1.

The present application, filed under 35 U.S.C. §371 is a national-stage application; the Examiner is therefore **required** to apply the unity of invention standard.

II. Unity of invention exists as between all of Applicants' claims

MPEP 1850 provides:

> Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on

> the contents of the claims as interpreted in light of the description and drawings. Annex B also contains examples concerning unity of invention.

Id at page 800-61.

MPEP 1893.03(d) similarly provides:

> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions as amended July 1, 1992 contained in Appendix AI of the MPEP.

Id at page 1800-149.

In the present case, unity of invention exists among all of Applicants' claims. The claimed polypeptide sequences and the claimed polynucleotide sequences encoding them are corresponding technical features which are common to all of Applicants claims, which serve to technically interrelate all of Applicants' claims, and which define the contribution over the prior art made by each of them. Thus, Applicants' claims are linked to form a single general inventive concept, and Applicants are therefore entitled to prosecute all of their pending claims in a single national stage application.

A. <u>The claimed polypeptide sequences, and the claimed polynucleotide sequences encoding those polypeptide sequences, are corresponding technical features that are common to all of Applicants' claims and that serve to technically interrelate them</u>

Applicants' claims recite *inter alia* the polypeptides SEQ ID NO:1-2, 4-16, 18-25, and 27-37, and polynucleotides encoding those polypeptides, which sequences include the polynucleotide sequences SEQ ID NO:38-39, 41-53, 55-62, and 64-74. Applicants have elected the claimed polypeptide sequence SEQ ID NO:28, and the claimed polynucleotide sequence encoding it, SEQ ID NO:64, that are corresponding technical features, given that the former are encoded by the latter, and conversely, the latter encodes the former.

Further, the claimed polypeptide and corresponding polynucleotide sequences are common to all of Applicant's claims, given that each claim refers to one or both either explicitly or implicitly, by virtue of depending from a claim which makes an explicit reference to the

claimed sequences.

Moreover, the claimed polypeptide and corresponding polynucleotide sequences serve to technically interrelate all of Applicants' claims. Applicants' composition of matter claims (claims 1-8, 10-12, 16-17, 20 and 23) are drawn to either the polypeptide and polynucleotide sequences themselves (claims 1 and 2, drawn to polypeptide sequences, and claims 3-5 and 11-12 drawn to polynucleotide sequences), to compositions of matter which comprise the sequences as one element (claims 6-8, drawn to a promoter sequence linked to the claimed polynucleotide, a transformed cell, and a transgenic organism, respectively, and claims 16-17, drawn to a composition comprising a polypeptide of claim 1), or to compositions of matter wherein the claimed sequences functionally limit the claimed subject matter (claim 10, drawn to an antibody which specifically binds a polypeptide of claim 1, claim 20 drawn to a composition comprising an agonist of the polypeptide of claim 1, and claim 23 drawn to a composition comprising an antagonist of the polypeptide of claim 1).

In Applicants' method claims (claims 9, 13-15, 18-19, 21-22, and 24-28), the claimed sequences serve as either the product of the claimed method (claim 9, drawn to a method of polypeptide production) and/or as a reagent for performing the method (claims 13-15 and 27-28, wherein the reagent is the claimed polynuceotide, and claims 18-19, 21-22, and 24-26, wherein the reagent is the claimed polypeptide.)

Therefore, the claimed polypeptide and polynucleotide sequences are corresponding technical features which are common to all of Applicants' claims, and which serve to technically interrelate them.

Applicants therefore request reconsideration of the Restriction Requirement and examination of all of claims 1-28 with respect to SEQ ID NOs:28 and 65.

In the event the Examiner maintains the Restriction Requirement, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

CONCLUSION

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108.**

Respectfully submitted,

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